

*REMARKS/ARGUMENTS**Suspension of Action*

In accordance with 37 CFR 1.17(i), Applicant requests a suspension of action. Please charge Deposit Account No. 12-1216 for the appropriate fee of \$130.00.

*The Present Invention*

The present invention relates to a pigmented cosmetic composition comprising a water-in-oil emulsion, in which the emulsion comprises (a) an oil phase; (b) an aqueous phase; (c) a pigment; (d) an emulsifier; and (e) a separation inhibitor comprising a silicone elastomer.

*The Pending Claims*

Claims 1, 7-9, 11-32, and 53-58 are currently pending. Reconsideration of the pending claims is respectfully requested.

*The Amendments to the Claims*

The pending claims have been amended so as to more particularly point out and distinctly claim the present invention. In particular, the features of claims 2-4 and 6 have been incorporated into independent claims 1, 28, 29, and 58. As a result, claims 2-4 and 6 have been canceled as superfluous. Claims 1, 28, 29, and 58 also have been amended to recite that the composition comprises from about 3% to about 6% by weight of a cetyl dimethicone copolyol emulsifier. Claim 29 also has been amended to recite a weight percent range of the sunscreensing agent. This amendment is supported by the specification at, for example, page 13, lines 9-14. In addition, since claim 52 is a substantial duplicate of amended claim 1, claim 52 has been canceled. No new matter has been added by way of these amendments.

*Summary of the Office Action*

The Office maintains the rejection of claims 1-4, 6-9, 11-32, and 52-58 under 35 U.S.C. § 103(a) as allegedly obvious over Hollenberg et al. (U.S. Patent No. 5,143,722) in view of Collin et al. (U.S. Patent No. 5,656,672) and Guthauser (U.S. Patent No. 5,162,378).

In addition, claims 1-4, 6-9, 11-32, and 52-58 stand rejected under 35 U.S.C. § 103(a) as allegedly obvious over Stepniewski et al. (U.S. Patent No. 5,599,533) in view of Rapaport (U.S. Patent No. 5,730,991) and Dorogi et al. (U.S. Patent No. 5,882,661).

#### *Examiner Interview*

Applicant wishes to thank Examiners Jiang and Padmanabhan for the courtesies extended to one of his agents, Kristen J. Harrell, during the telephone interviews held on November 16 and 17, 2005. Potential claim amendments and additional experimental testing were discussed. Examiner Jiang indicated that additional examples of the inventive composition to illustrate the claim breadth and unexpected results would be beneficial to advance prosecution.

#### *Discussion of Rejections*

##### *(A) Hollenberg et al., Collin et al., and Guthauser*

Hollenberg et al. allegedly discloses a water-in-oil cosmetic composition containing an oil phase, water phase, a pigment, a sunscreensing agent, an emulsifier with an HLB value from 2 to 12 in 0.25-2 wt%, a thickener, an inorganic salt, a silicone elastomer, a glycol, and a preservative. The Office concedes that Hollenberg et al. does not disclose the use of a cetyl dimethicone copolyol in 3-6 wt% in the recited water-in-oil emulsion. Collin et al. allegedly discloses a water-in-oil cosmetic composition comprising an oil phase, a water phase, an emulsifier such as cetyl dimethicone copolyol in 0.5-10 wt%, and inorganic salts. Guthauser discloses a water-in-oil emulsion comprising 8-20 wt% cetyl dimethicone copolyol with an HLB value from 4 to 6, water, silicone elastomer, inorganic salts, and PEG. According to the Office, it would have been obvious, based on the disclosures of Guthauser and Collin et al., to use cetyl dimethicone copolyol emulsifier in 3-6 wt% in the water-in-oil compositions of Hollenberg et al. in order to arrive at the present invention.

As previously discussed, the combination of Hollenberg et al., Collin et al., and Guthauser does not render the present inventive composition obvious. According to the Office, Hollenberg et al. describes using an emulsifier with an HLB value of 2-12 (see col. 6, line13). However, Hollenberg et al. states that this particular type of emulsifier is a *silicone-*

*free* surfactant. Thus the emulsifier with an HLB value of 2-12 described in Hollenberg et al. *cannot* comprise cetyl dimethicone copolyol, which contains silicone.

The composition of Hollenberg et al. can comprise a polydiorganosiloxane-polyoxyalkylene copolymer surfactant with an HLB value of about 2.5 to about 6 (see col. 4, line 20- col.6, line 4). However, this surfactant is limited to those with alkyl substituents of six or fewer carbon atoms (see col. 4, lines 38-49). Again, the surfactant described by Hollenberg et al. *cannot* comprise a cetyl dimethicone copolyol, which contains C<sub>16</sub> alkyl groups (i.e., *more* than 6 carbons).

Thus, Hollenberg et al. teaches away from adding an emulsifier that either (a) contains silicone or (b) contains alkyl substituents with *more* than 6 carbons. Cetyl dimethicone copolyol contains silicone *and* alkyl substituents with more than 6 carbons. Even though Collin et al. describes the use of 1-6 wt% of a silicone-containing emulsifying agent (col. 3, lines 39-50), including the use of a cetyl dimethicone copolyol, one of ordinary skill in the art would not even look to Collin et al.'s disclosure because Hollenberg et al. expressly teaches that silicone-containing emulsifying agents such as cetyl dimethicone copolyol should *not* be used. Therefore, since Hollenberg et al. teaches away from using a cetyl dimethicone copolyol emulsifier, it cannot be said that one would be motivated to modify the composition of Hollenberg et al. and add a cetyl dimethicone copolyol.

The Office cites *In re Princeton Biochemicals, Inc.* to support the assertion that the knowledge of those skilled in the art and the nature of the problem to be solved were enough to provide the motivation to combine elements from various references. Applicant respectfully submits that the *In re Princeton Biochemicals, Inc.* case is inapposite to the present application. In the *In re Princeton Biochemicals, Inc.* case, the plaintiff (patent holder) did not rebut the defendant's expert's testimony that the motivation to combine the references at issue was found in the knowledge of those skilled in the art at the time the invention was made. Significantly, however, the case does not dispense with the requirement that, to make a *prima facie* case of obviousness, a suggestion or motivation to modify the reference or to combine reference teachings is required. *See, e.g.*, § 2143.01 of the M.P.E.P. It is still the burden of the Patent Office to provide sufficient evidence of such suggestion or motivation and not merely make allegations. In the present application, the Office has not

provided a reasonable basis to conclude that one of ordinary skill in the art would have been motivated to modify the cited references in such a way so as to arrive at the claimed invention. In particular, the Office provides no authority in the case at hand to attest to what would be found in the knowledge of one of ordinary skill in the art, unlike the *In re Princeton* case where there was expert testimony that was then unrebutted. A mere conclusory statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). “Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability,” this amounts to nothing more than impermissible hindsight.” *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617. (Fed. Cir. 1999). Therefore, Applicant is of the belief that the Office has not satisfied its burden to establish a *prima facie* obviousness rejection.

Moreover, it is not sufficient to look at one part of Hollenberg’s disclosure while ignoring the remaining teachings. References must be considered as a whole. Indeed, Hollenberg et al. states that a surfactant that has an HLB value of 2 to 12 can be used—which would include a cetyl dimethicone copolyol—however, in the same sentence, Hollenberg et al. states that this surfactant with an HLB value of 2 to 12 is “organic, silicone-free” (col. 6, lines 11-16). As discussed above, this statement immediately removes a cetyl dimethicone copolyol as a suitable surfactant in the composition disclosed by Hollenberg et al.

Without a proper *prima facie* case of obviousness and with no motivation for one of ordinary skill in the art to combine the disclosures of Hollenberg et al., Collin et al., and Guthauser, claims 1, 7-9, 11-32, and 53-58 are unobvious. Accordingly, the obviousness rejection in view of these references should be withdrawn.

*(B) Stepniewski et al., Rapaport, and Dorogi et al.*

Stepniewski et al. allegedly discloses cosmetic compositions comprising water-in-oil emulsions comprising an oil phase, a water phase, a pigment, a sunscreensing agent including

a preservative, an emulsifier or surfactants with an HLB value of 2-6 in 0.01-20 wt% or cetyl dimethicone copolyol in 0.5 wt%, a thickener, a separation inhibitor, a silicone elastomer, and an inorganic salt. The Office concedes that Stepniewski et al. does not expressly disclose the use of a cetyl dimethicone copolyol in about 3-6 wt%. Rapaport discloses a skin peel composition that can include octyl methoxycinnamate as a sunscreen agent. Dorogi et al. discloses a composition for treating or conditioning human skin, hair, or nails. The composition can include phenoxyethanol, propyl paraben, and methyl paraben as preservatives. According to the Office, it would have been obvious to combine the elements disclosed by Rapaport and Dorogi et al. with the compositions taught by Stepniewski et al. in order to arrive at the instant invention. The Office contends that since Stepniewski et al. describes using a surfactant in 0.01-20 wt% (preferably 1-4 wt%) and also describes using a cetyl dimethicone copolyol, it would have been obvious to optimize this parameter to arrive at the limitation of 3-6 wt%.

The combination of Stepniewski et al., Rapaport, and Dorogi et al. does not render the present inventive compositions obvious. Rapaport and Dorogi et al. do not even mention the use of a cetyl dimethicone copolyol in any amount, let alone in the amount of about 3-6 wt%. Stepniewski et al. broadly describes the use of a surfactant in the range of about 0.01-20 wt%.

Applicant has unexpectedly discovered that adding about 3-6 wt% of a cetyl dimethicone copolyol emulsifier to the water-in-oil emulsion lends unusual stability to the present invention. As seen in the previously submitted Rule 132 Declarations, compositions of the present invention comprising about 3-6 wt% cetyl dimethicone copolyol were stable for at least three months at 50 °C.

In contrast, compositions comprising a cetyl dimethicone copolyol emulsifier in an amount outside of the claimed range (e.g., comprising about 1 wt% and about 8 wt% cetyl dimethicone copolyol) were *not* similarly stable. Thus, even though Stepniewski et al. describes using a surfactant in the range of about 0.01-20 wt%, Applicant has shown that values *outside* of the claimed range (i.e., about 1 wt% and about 8 wt% cetyl dimethicone copolyol) but falling *within* the broad range of 0.01-20 wt%, do not provide a stable emulsion. Therefore, it cannot be said that Stepniewski et al. renders the present invention obvious, since Stepniewski et al. clearly does not appreciate any benefit in providing a

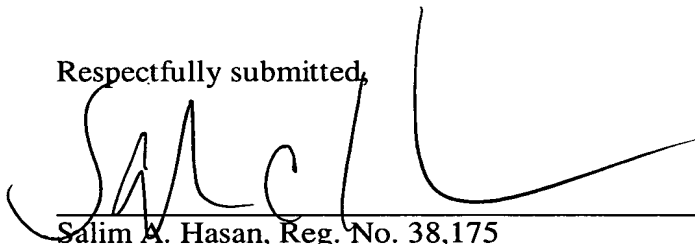
composition comprising about 3-6 wt% of a cetyl dimethicone copolyol. Regarding the Examiner's contention that Stepniewski's disclosure of 0.5 wt% of a cetyl dimethicone copolyol meets the claims limitation of about 3-6 wt% of an emulsifier *comprising* a cetyl dimethicone copolyol, the claims have been amended to remove the comprising language in this instance.

In view of the surprising and unexpected stability of the inventive composition and without the motivation to include about 3-6 wt% of a cetyl dimethicone copolyol as an emulsifier to a water-in-oil emulsion based on the disclosures of Stepniewski et al., Rapaport, and Dorogi et al., claims 1, 7-9, 11-32, and 53-58 are unobvious. Accordingly, the obviousness rejection in view thereof should be withdrawn.

*Conclusion*

Applicants respectfully submit that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



Salim A. Hasan, Reg. No. 38,175  
LEYDIG, VOIT & MAYER, LTD.  
Two Prudential Plaza, Suite 4900  
180 North Stetson Avenue  
Chicago, Illinois 60601-6780  
(312) 616-5600 (telephone)  
(312) 616-5700 (facsimile)

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